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REMARKS

Amendment to the Claims

Claims 1, 4, 8 and 11 have been amended to maintain consistency with the claim language with each other; it is believed that no change in scope has been made in using the same claim language.

Claims 1, 5 and 12 have been amended to correct the spelling of the term "flavonoid". Examiner's action stated "flavonoids [sic]", but this is the correct spelling for the term and the applicants previously used the misspelled term "flavanoids".

Claims 13 and 14 have been added to incorporate additional limitations of the scope of the flavone, flavanone and/or flavonoid. Support for this limitation can be found throughout the specification, e.g. page 14, last two paragraphs.

Claims 15-17 have been added and are similar to claims 4, 5, 13 and 14 with each of claims 15-17 being subject to a narrower limitation.

Claims 18-20 have been added and are similar to claims 11-14 with each of claims 18-20 being subject to a narrower limitation.

Claims 1-5 and 7-20 are now pending. It is believed that no new matter has been added.

35 U.S.C. 103(a) rejection

Claims 1-5 and 7-12 have been rejected over Gers-Barlag et al. (WO 98/42300) in view of Msika (U.S. Patent 5,939,054) and Plaschke (U.S. Patent 6,409,996).

Note: U.S. Patent 6,440,399 and 6,558,683 are English language equivalents of Gers-Barlag et al. (WO 98/42300) and for ease of communication will be referred to in the response to the rejection although the rejection is based on the WO.

Gers-Barlag et al. reference

The examiner indicates that Gers-Barlag et al. '399 and '683 fails to teach: (1) phyllosilicate and (2) the flavone, flavanone and/or flavonoid. (It is also noted that the present invention is a **water-in-oil system** whereas the '399 and '683 patents are **oil-in-water systems** - applicants specification references WO 98/42301 which is directed toward water-in-oil systems - see page 8, fourth to last line of specification)

More accurately, Gers-Barlag et al. does not teach "at least one modified phyllosilicate which exhibits both hydrophilic and lipophilic properties and positions itself at the water/oil interface." Gers-

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Barlag et al. mentions phyllosilicates (see e.g. col. 5, lines 51-60 of the '399 patent), but does not indicate that these phyllosilicates possess the properties claimed by the applicants. Moreover, Gers-Barlag et al. teaches use of phyllosilicates as thickeners and as such represents a teaching away as the thickener would be appear to be interspersed throughout the continuous phase (which in the case of an oil-in-water system would be the water), not at the interface between oil and water.

Application of the Msika and Plaschke references does not remedy the deficiencies of the Gers-Barlag et al. references.

No direction to make substitutions to Gers-Barlag et al. as suggested by examiner

(a) *Infinite permutations is not indicative of obviousness*

The legal concept of *prima facie* obviousness is described in MPEP 2142 and requires that the references be considered as a whole for their teachings as ascertained by one of ordinary skill in the art at the time the applicant's invention was made and that this is done without the benefit of the applicants' claims to provide a road map for establishing obviousness. This concept is further illustrated in *re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988) which ruled that

"It is essential that 'the decisionmaker forget what he or she has been taught at trial about the claimed invention **and cast the mind back to the time the invention was made...**to occupy the mind of one skilled in the art **who is presented only with the references**, and who is normally guided by the then-accepted wisdom in the art.' *Id.* One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Id.* at 1599, 1600.

Therefore, the question presented before us is what would one of ordinary skill in the art would have found to be obvious when presented with the Gers-Barlag et al., Msika and Plaschke references as of 18 July 2000 (or 20 July 1999) without the applicants' claims before them?

As acknowledged by the examiner, Gers-Barlag et al. does not teach the modified phyllosilicate or the flavone/flavanone/flavonoid elements. The Msika reference is cited to show the use of modified phyllosilicates and the Plaschke reference is used to show the use of flavanoid compounds (in both

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references in sunscreens compositions). The examiner's rejection appears to acknowledge that each reference individually does not teach the applicants' claimed invention. However, even collectively, these references do not render the applicants' invention to be obvious.

Each of Gers-Barlag et al., Msika and Plascke teach compositions which have multiple components to their compositions and when considering the optional ingredients explicitly suggested in their teachings, the number of permutations of possible embodiments of their invention is virtually limitless.

It has previously been held in *In re Rice*, 178 USPQ 478 (CCPA 1973) that, "...the board said, referring to the appellant's ingredients, 'It should be noted that an infinite number of combinations is possible.' Accepting that as an approximation to the truth, we fail to see the obviousness in devising appellant's.....[invention] as claimed." *Id.* at 480.

Moreover, the examiner's motivation for making the appropriate substitution from Msika and Plaschke's reference appears to take the teaching for a single components in isolation, i.e. the inventive concept of these respective inventions is the entirety of the composition not a single component and as such it is improper to pick and choose the necessary element to fill in the necessary requirements for a *prima facie* case of obviousness especially when the skilled artisan would not have the benefit of the applicants' claims when presented with the cited references at the time the invention was made.

(b) Teaching away is not addressed by prior art

Lastly, the state of the art with respect to the use of flavone/flavanone/flavonoid compounds was described in the specification as being disadvantageous due to their instability (see page 6, last paragraph of specification) and as such this represents a teaching away from their use in the compositions of Gers-Barlag et al.

As such, even if it could be shown that the combination of Gers-Barlag et al. and Msika approximates the applicants' claimed invention with the exception of the flavone/flavanone/flavonoid compounds, not only is there no motivation to add the flavone/flavanone/flavonoid compounds, there is a teaching away from their use in a composition with the elements contained in the composition of Gers-Barlag et al. or that of the applicants' claimed invention.

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As obviousness is a legal conclusion based on factual findings, the applicants present that even if there were a proper basis for picking and choosing flavone/flavanone/flavonoid compounds from within the Plaschke reference, there is no factual basis for inclusion of flavone/flavanone/flavonoid compounds which counters the known state of the art with respect to the use of flavone/flavanone/flavonoid compounds.

Conclusion

Therefore, it is believed that the applicants' claimed invention is unobvious in view of the prior art because:

- (1) There is no direction to select the specific elements of Msika and Plaschke and substitute them into the teaching of Gers-Barlag et al.
- (2) The use of flavone/flavanone/flavonoid compounds are known to be problematic within the art and as such there is an even higher standard of direction/motivation for combining the references which has not been met.

Double Patenting Rejection

Claim 1-6 and 7-12 have been rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-16 of Gers-Barlag et al. (U.S. Patent 6,592,883) in view of Gers-Barlag et al. (U.S. Patent 5,952,391).

MPEP 804 recites the criteria as to whether an obviousness-type double patenting rejection applies – "...the first question to be asked is – does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent?" While an obviousness-type double patenting rejection has elements which are similar to an obviousness rejection (see MPEP 804, page 800-22), they are not the same.

In addition to the *Graham v. John Deere* analysis, any obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims – a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in a claim in the patent.

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As such, the rule for almost all obviousness-type double patenting rejections is that they are based upon one patent whose claims are directly compared against the claims pending in the application (i.e. no secondary references are permitted to formulate the rejection as the examiner has done in the above rejection).

The exception to the rule is an *In re Schneller*-type rejection which permits the use of additional references to be combined with the primary reference (MPEP 804 B.2. - Another Type of Nonstatutory Double Patenting Rejection). However, there is no explanation as to why it is believed an *In re Schneller*-type situation exists here. The examiner is reminded that this section of MPEP 804 recites:

"Nonstatutory double patenting rejections based on *Schneller* will be rare. The Technology Center (TC) Director must approve any nonstatutory double patenting rejections based on *Schneller*. If an examiner determines that a double patenting rejection based on *Schneller* is appropriate in his or her application, the examiner should first consult with his or her supervisory patent examiner (SPE). If the SPE agrees with the examiner then ***approval of the TC Director must be obtained before such a nonstatutory double patenting rejection can be made.***" (emphasis in bold and italics added)

There is no indication in the office action that a *Schneller*-type situation exists here or that this has been confirmed with the Group 1600 TC Director.

Closing

Applicants also believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Respectfully submitted,

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